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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

8

Application Number	10/611,419
Filing Date	June 30, 2003
First Named Inventor	Fu
Art Unit	2652
Examiner Name	Chen, Tianjie

Attorney Docket Number	Q01-1041-US1 / 11198.71
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ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): - Return Receipt Postcard
Remarks		
SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT		
Firm Name	Law Office of Steven G. Roeder	
Signature		
Printed name	James P. Broder	
Date	February 21, 2006	Reg. No. 43,514

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Signature	
Typed or printed name	James P. Broder

Date February 21, 2006

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEE TRANSMITTAL For FY 2006

Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$)
0.00

Complete if Known	
Application Number	10/611,419
Filing Date	June 30, 2003
First Named Inventor	Fu
Examiner Name	Chen, Tianjie
Art Unit	2652
Attorney Docket No.	Q01-1041-US1 / 11198.71

METHOD OF PAYMENT (check all that apply)

Check Credit Card Money Order None Other (please identify): _____
 Deposit Account Deposit Account Number: 50-1141 Deposit Account Name: Steven G. Roeder

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

Charge fee(s) indicated below Charge fee(s) indicated below, except for the filing fee
 Charge any additional fee(s) or underpayments of fee(s) Credit any overpayments under 37 CFR 1.16 and 1.17

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FEE CALCULATION (All the fees below are due upon filing or may be subject to a surcharge.)

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		
	Fee (\$)	Small Entity	Fee (\$)	Small Entity	Fee (\$)	Small Entity	
Utility	300	150	500	250	200	100	~
Design	200	100	100	50	130	65	~
Plant	200	100	300	150	160	80	~
Reissue	300	150	500	250	600	300	~
Provisional	200	100	0	0	0	0	~

2. EXCESS CLAIM FEES

Fee Description

Each claim over 20 (including Reissues)

Small Entity
Fee (\$)

50 25

Each independent claim over 3 (including Reissues)

200 100

Multiple dependent claims

360 180

Total Claims

52 - 20 or HP = 0 x 50 = 0

Multiple Dependent Claims

Fee (\$) Fee Paid (\$)

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims

6 - 3 or HP = 0 x 200 = 0

HP = highest number of independent claims paid for, if greater than 3.

Fee (\$) Fee Paid (\$)

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets Extra Sheets Number of each additional 50 or fraction thereof Fee (\$) Fee Paid (\$)
 - 100 = / 50 = (round up to a whole number) x =

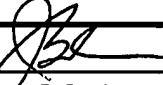
4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Fees Paid (\$)

Other (e.g., late filing surcharge): _____

SUBMITTED BY

Signature 

Registration No.
(Attorney/Agent) 43,514

Telephone 858-487-4077

Name (Print/Type) James P. Broder

Date February 21, 2006

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Fu, et al.)
Serial No: 10/611,419) Art Unit
Filed: June 30, 2003) 2652
For: POSITIONER FOR A DISK DRIVE THAT)
OFFSETS THE RESULTANT FORCE AT THE)
ACTUATOR HUB TO PRECISELY POSITION)
A DATA TRANSDUCER)
Examiner: Chen, Tianjie)
Attorney Docket: Q01-1041-US1 / 11198.71)

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Restriction Requirement dated February 7, 2006, having a shortened statutory period for response set to expire on March 7, 2006, please review the above-captioned patent application as provided below. This response is timely filed within the one-month deadline for response.

CERTIFICATE OF MAILING UNDER 37 CFR §1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this the 21st day of February, 2006.

JAMES P. BRODER, Attorney for Applicants – Registration No. 43,514

ELECTION

The Applicants respectfully elect with traverse the claims of Species I, which Applicants believe comprises claims 69-120. Applicants further respectfully submit that at least claims 69-70, 78-80, 88-91, 96-98, 103, 113 and 120 are believed to be generic to Species I, II and III as defined by the Patent Office. Further, claims 69-120 are believed to be subgeneric, as these claims are believed to read on both Species I and II.

ARGUMENT

The Applicants respectfully traverse the election requirement with respect to election of a single species as defined by the Patent Office. The Patent Office has determined that the “application contains claims directed to the following patentably distinct species of the claimed invention: Species I: drawn from Figures 2A-2C; Species II: drawn from Figure 3; Species III: drawn from Figure 4.” As set forth below, the Applicants submit that the restriction requirement is improper and should be withdrawn.

First, the guidelines of the statutes and the rules govern whether a restriction requirement is proper. More specifically, 35 U.S.C. § 121 states in relevant part: “If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions.” (35 U.S.C. § 121; emphasis added).

Further, 37 CFR 1.142(a) states in relevant part: “If two or more independent and distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted, this official action being called a requirement for restriction (also known as a requirement for division).” (37 CFR 1.142(a); emphasis added).

In the context of a restriction requirement, MPEP § 802.01 defines “independent” as follows: “The term ‘independent’ (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect, for example: (1) species under a genus which species are not usable together as disclosed; or (2) process and apparatus incapable of being used in practicing the process.” (MPEP § 802.01). The MPEP further clarifies the definition of “independent” by providing examples, stating in relevant part: “An article of apparel such

as a shoe, and a locomotive bearing would be an example. A process of painting a house and a process of boring a well would be a second example." (MPEP § 806.04(A)). In the present case, the differences between the three species set forth by the Patent Office are not nearly as glaring, and are much less bright-lined than the clear examples expressed above in MPEP § 806.04(A).

For example, all three of the species identified by the Patent Office are directed toward disk drives including a positioner that positions a data transducer, the positioner having a magnet assembly and one or more conductors, or methods for positioning a data transducer that include use of such a positioner. In accordance with the Figures upon which the Patent Office relies in identifying the various species, each of the conductors has several substantially similar features to one another. As a consequence, the Applicants submit that the different species set forth by the Patent Office are not independent.

In the Restriction Requirement, the Examiner appears to have drawn a distinction between the components illustrated in Figures 2A-2C, 3 and 4 of the present application based upon the shapes, configurations and/or positioning of the magnet assembly and the conductor(s) of the positioner in the disk drive. However, the Patent Office appears to be disregarding that the structural components included in the embodiments illustrated in the Figures are not completely unconnected in design, operation, or effect, as required for a finding of independent inventions.

Moreover, "for purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02." (Guidelines, MPEP 803; emphasis added). The Applicants respectfully submit that the Patent Office has not adequately demonstrated reasons or examples to support its conclusions. Moreover, the Patent Office has not provided any explanation of separate classification or separate status in the art for the various species, or that different fields of search are required to examine the claims of each species together in one application.

Thus, the Applicants respectfully submit that the species identified by the Patent Office (solely by Figure numbers) are not wholly unconnected in design, operation, or

effect. Accordingly, the Applicants submit that examining the embodiments illustrated in Figures 2A-2C, 3 and 4 can potentially be performed together without conducting an additional search. Thus, the restriction requirement should be withdrawn or modified accordingly.

Based on the foregoing, the Applicants assert that the election requirement with respect to the Species is improper, and should be withdrawn. Consequently, the claims of Species I-III, comprising claims 69-120, should be examined together as required by the Species designations of the Patent Office, and pursuant to MPEP 802.01 and 803.